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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,991	05/20/2004	Rocco Burgo	I0113-38UI	8754
54380 7590 01/09/2008 FLASTER/GREENBERG P.C. 8 PENN CENTER 1628 JOHN F. KENNEDY BLVD. 15TH FLOOR PHILADELPHIA, PA 19103			EXAMINER CHANNAVAJJALA, LAKSHMI SARADA	
			ART UNIT 1611	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/849,991

Applicant(s)

BURGO, ROCCO

Examiner

Lakshmi S. Channavajjala

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9-9-05</u> .  | 6) <input type="checkbox"/> Other: ____                           |

### **DETAILED ACTION**

Receipt of IDS dated 9-9-05 is acknowledged.

Claims 1-14 are pending in the instant application.

#### ***Priority***

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No: 60/462,097, filed 4-9-03 (not 5-20-2003) fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The above provisional application is directed to an entirely different invention from that of the instant. It appears that the applicants meant to claim priority to provisional application 60/472,097 and that the application 60/462,097 is a typographical error.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of US 5,833,961 or US 5,989,527 to Siegfried et al (Siegfried).

The disclosures of the above US patents to Siegfried are similar and therefore the disclosure of '961 is relied upon for the teachings. '961 disclose a polyester based sunscreen composition comprising polyol polyesters and sunscreen active agents. The exemplified compositions do not contain any silicone fluids and hence meet the negative limitation of claim 1. For the polyol polyesters, '961 teach that the polyester is a reaction product of at least one linear or branched aliphatic compound having two OH (diol) groups and at least one linear or branched chain aliphatic dicarboxylic acid and the diol may contain 2 to 10 ether linkages (col. 3, L 45-54). '961 further describes that the carboxylic acids contain 2 to 20 carbon atoms (col. 4, L 15-25) and the diols such as those recited in instant claim (col. 4, L30-45). For the preparation of the polyester, see lines bridging col. 4-5. Instant claim 8 does not recite any method and instead only recites a composition, which is taught by '961. For claims 5 and 13, '961 describe formula I, which meets the instant claimed formula. Therefore, the above patents of Siegfried anticipate instant claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of US 5,833,961 or US 5,989,527 to Siegfried et al (Siegfried).

The disclosures of the above US patents to Siegfried are similar and therefore the disclosure of '961 is relied upon for the teachings. '961 disclose a polyester based sunscreen composition comprising polyol polyesters and sunscreen active agents. The teachings of the above patents are described above. Instant claims 4 and 12 recite specific carboxylic acids that form the polyester. While neither of the Siegfried patents mentioned above describe polyesters having only those claimed carboxylic acids, Siegfried states that their polyesters formed from a reaction of a diol and a diacid may further have the terminal end groups functionalized by reacting with a monofunctional acid having 2 to 40 carbon atoms such as propionic acid, butyric acid etc (col. 5, L 53 through col. 6, L20). Instant claims do not exclude polyol polyester that is a reaction product of diol and a diacid and also a monofunctional acid. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare polyol polyester containing both a monofunctional carboxylic acid as well as a diacid and still expect an effective sunscreen composition would have been within the scope of a skilled artisan because Siegfried teaches that the polyester compounds are

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effective in reducing the degree of penetration of the sunscreen composition through the outer stratum with the compounds having their end groups left as is or further functionalized.

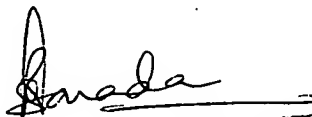
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615

January 2, 2008

  
LAKSHMI S. CHANNAVAJJALA  
PRIMARY EXAMINER